

In the Claims:

Cancel Claim 35.

REMARKS

This application is a continuation of copending U.S. patent application Serial No. 09/469,662, filed December 22, 1999, which is a divisional of U.S. patent application Serial No. 09/325,936, filed June 4, 1999, now U.S. Patent No. 6,182,831 B1, issued February 6, 2001.

In order to advance the prosecution by way of further response to the final Office Action dated July 18, 2001 (Paper No. 8), in the immediate parent application No. 09/469,662 (now abandoned), the specification has been amended beginning at page 1, at line 4 to reflect the fact that the immediate parent application (Application No. 09/469,662) is a divisional of U.S. Application No. 09/325,936, filed June 4, 1999, now U.S. Patent No. 6,182,831 B1, issued February 6, 2001. Claim 35 has been canceled.

Claims 1, 3-27, and 29-34 are pending and stand rejected under the final Office Action dated July 18, 2001 (Paper No. 8), in the immediate parent application No. 09/469,662 (now abandoned).

The Double Patenting Rejection of Claims 1, 3-27 and 29-34:

Claims 1, 3-27, and 29-34 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-30 of U.S. Patent No. 6,182,831. Applicants respectfully traverse the rejection for the following reasons. The present application, filed January 18, 2002, is a continuation of U.S. Application No. 09/469,662, filed December 22, 1999. Application No. 09/469,662 is a divisional application of Application No. 09/325,936, filed June 4, 1999, now U.S. Patent No. 6,182,831 B1, issued February 6, 2001. The claims presented for examination in this application were originally in the grandparent

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application No. 09/325,936, which was given a restriction requirement dated October 26, 1999, based on Group I (Claims 1-35, 41, and 42, drawn to an apparatus and a method for magnetic separating of particles, classified in Class 209, subclass 213) and Group II (Claims 36-40 and 43 drawn to a mass spectrometer, classified in Class 356, subclass 326).

The Examiner stated that the restriction was proper, for although Group I and Group II were related as combination and subcombination, the combination as claimed did not require the particulars of the subcombination as claimed because the combination did not have a mass-energy-to-charge ratio and the subcombination had a separate utility such as a magnetic separator.

In application No. 09/325,936, applicants elected Group II in response to this restriction requirement, and the claims of Group I (now in the present application) were withdrawn from consideration by the Examiner. The withdrawn claims to Group I drawn to an apparatus and method for magnetic separating of particles are presented for examination in the present application which is a continuation of divisional Application No. 09/469,662.

M.P.E.P. § 804.01 (entitled "Prohibitions of Double Patenting Rejections Under 35 U.S.C. § 121") states in relevant part: "The third sentence of 35 U.S.C. § 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made . . . as a reference against any divisional application . . . filed before the issuance of the patent." This precisely describes the present fact situation.

Applicants respectfully submit that because the Examiner made a restriction requirement in Application No. 09/325,936 and, in compliance with 35 U.S.C. § 121, divisional Application No. 09/469,662 was filed before the issuance of Application No. 09/325,936, the rejection of Claims 1, 3-27 and 29-34 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-30 of U.S. Patent No. 6,182,831 is an improper

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rejection. Accordingly, applicants respectfully request withdrawal of this rejection of Claims 1, 3-27, and 29-34.

Telephone Interview with the Examiner Held on February 22, 2002

A telephone interview with Examiner Tuan Nguyen was held on February 22, 2002 by applicants' representative, Paul C. Cullom, Jr. (Registration No. 25,580). The Examiner and Mr. Cullom discussed the following points. The first point was that this application is a continuation of copending U.S. patent application Serial No. 09/469,662, filed December 22, 1999, which is a divisional of U.S. patent application Serial No. 09/325,936, filed June 4, 1999, now U.S. Patent No. 6,182,831 B1, issued February 6, 2001.

The second point was that M.P.E.P. § 804.01 states in relevant part: "The third sentence of 35 U.S.C. § 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made... as a reference against any divisional application... filed before the issuance of the patent." Mr. Cullom pointed out that this precisely describes the present fact situation.

Examiner Nguyen agreed to consider the foregoing points when the present continuation application file reached his desk.

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Conclusion

In view of the foregoing remarks, applicants respectfully submit that Claims 1, 3-27, and 29-34 are in condition for allowance. If any issues remain that may be expeditiously addressed in another telephone interview, the Examiner is encouraged to telephone applicants' attorney at (206) 695-1755.

Respectfully submitted,

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Date: May 9, 2002

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VERSION WITH MARKINGS TO SHOW CHANGES MADE MAY 9, 2002

In the Specification:

Please amend the paragraph beginning at page 1, line 4 to read as follows:

This application is a continuation of copending U.S. patent application Serial No. 09/469,662, filed December 22, 1999, which is a [continuation] divisional of U.S. patent application Serial No. 09/325,936, filed June 4, 1999, now U.S. Patent No. 6,182,831 B1, issued February 6, 2001, which is a continuation of international application Serial No. PCT/US98/21000, filed October 6, 1998, which is a continuation-in-part of U.S. provisional patent application Serial No. 60/061,394, filed October 7, 1997, priority of the filing dates of which is hereby claimed under 35 U.S.C. §§ 112 and 119, respectively. Each of these applications is incorporated herein by reference.

In the Claims:

Claim 35 is canceled.

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